

REMARKS

In the Office Action mailed on January 25, 2007, the Examiner withdrew claims 1-11, 13-17, 22, and 24 from consideration in response to Applicants' Response to Election Requirement filed on October 30, 2006; objected to claims 34-35 because of minor informalities; and rejected claims 25-42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Codos et al. (U.S. Patent No. 6,312,123) in view of Muranaka (U.S. Patent No. 6,004,052). The Examiner made the rejections final.

As an initial matter, Applicants would like to thank Examiner Liang for allowing and conducting the telephonic interview of April 18, 2007. The substantive matters discussed in the interview are incorporated in the remarks set forth below. Applicants respectfully submit that the finality of the final Office Action is improper. Specifically, in the Office Action mailed on April 6, 2006, the subject matter of then pending dependent claims 12 and 13 were objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Both dependent claims 12 and 13, as originally filed, depended directly from independent claim 1. In the Amendment filed on July 6, 2006, Applicants incorporated the subject matter of then pending claim 12 into its base independent claim 1, cancelled then pending dependent claim 12, and combined the subject matter of independent claim 1 and dependent claim 13 to create new independent claim 25. In drafting independent claim 25, Applicants merely renamed the "the third heating section" of claim 13 to a "second heating section" in claim 25 for formality and consistency purposes. The remaining limitations of dependent claim 13 were explicitly combined with limitations of claim 1 to create new independent claim 25. Subsequently, in the outstanding final Office Action, claim 25, which included the

subject matter of originally filed claims 1 and 13, was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Codos et al. in view of Muranaka. Thus, despite the identical subject matter of then pending claims 1 and 13, and new claim 25, a new ground for rejection was issued in the final Office Action. And, for the first time, the Examiner specifically addressed and rejected the subject matter claimed in originally filed dependent claim 13. See Office Action at Page 6.

While the Examiner may make a new ground for rejection, even after indicating the allowability of the subject matter of a claim, Applicants dispute that this rejection can be made final. As set forth in M.P.E.P. § 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims." As the new ground for the rejection (a rejection over Codos et al. and Muranaka, instead of no rejection of the subject matter of claim 13) of the subject matter of claim 25, was not necessitated by Applicants' amendment or presentation of new claim 25, as the subject matter of claim 25 was previously pending as claims 1 and 13, Applicants respectfully request withdrawal of the finality of the Office Action and, as a matter of right, the entry of the amendments presented in this paper.

By this Amendment, Applicants have amended claims 25, 34, and 35, and cancelled claim 27. The amendments to claim 25 merely incorporate the subject matter of now cancelled claim 27, and the amendments to claims 34 and 35 serve to respond to the Examiner's objections of these claims and further define the claimed invention. Accordingly, claims 1-11, 13-17, 22, 24-26, and 28-42 are currently pending. Of these

claims, claims 1-11, 13-17, 22, and 24 have been withdrawn from consideration. Claim 25 is the sole examined pending independent claim. No new matter is introduced.

Applicants respectfully traverse the Examiner's rejection of claims 25-42 over Codos et al. in view of Muranaka. Neither reference, taken alone or in combination, discloses, teaches, or otherwise suggests each and every element of independent claim 25. In particular, the applied references at least fail to disclose the claimed combination, including an image recording device having, among other things, a first heating section which heats ultraviolet-ray curable ink on a recording medium after an irradiation of ultraviolet rays, where the heating time of the first heating section is in the "range between 0.1 and 10 seconds."

The Examiner contends that the heated drying section 26 of the Codos et al. quilting machine 10 correspond to the claimed first heating section. Applicants respectfully disagree. Even assuming that heated drying section 26 and the structure of quilting machine 10 meet the other recitations of claim 25, which Applicants do not concede, Codos et al. does not teach, disclose, or otherwise suggest that the heating time for the heated drying section 26 is in the range between 0.1 and 10 seconds, as required by independent claim 25. To the contrary, Codos et al. explicitly discloses that "heating of from 30 seconds to 3 minutes is the anticipated acceptable range" for heating by heated drying section 26. See col. 5, lines 28-31. Accordingly, Codos et al. fails to teach, disclose, or otherwise suggest each and every element of amended independent claim 25.

The Examiner has relied on Muranaka principally for the alleged teaching of a second heating section. See Office Action at pages 6-8. Therefore, Muranaka fails to

cure the above-described deficiencies of Codos et al., and the Examiner's proposed combination of Codos et al. and Muranaka does not teach, disclose, or otherwise suggest each and every limitation of independent claim 25.

Accordingly, claim 25 and its dependent claims 26 and 28-42 are patentable over these references.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and/or drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.


Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 25-26 and 28-42 in condition for allowance. Applicants submit that the proposed amendments to claims 25, 34, and 35 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, as the added recitations were previously presented for examination. In particular, the amendments to claim 25 substantially include the recitations of now cancelled claim 27. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final Office Action by the Examiner presented some new arguments as to the application of the art against

Applicants' invention. It is respectfully submitted that the entering of this Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of this Amendment would place the Application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited in this application. Applicants therefore request the withdrawal of the finality of the outstanding Office Action, the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

 Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: April 19, 2007

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